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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,374	05/10/2001	Masao Nakagawa	13425.11US01	5423

7590 11/12/2004

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EXAMINER	
FADOK, MARK A	
ART UNIT	**PAPER NUMBER**
3625	

DATE MAILED: 11/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/852,374	NAKAGAWA, MASAO	
	Examiner	Art Unit	
	Mark Fadok	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *8/16/2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *1-6 and 8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6 and 8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10 May 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The examiner is in receipt of applicant's response to office action mailed 4/13/2004, which was received 8/16/2004. Acknowledgement is made to the amendment to claims 1-3 and the cancellation of claim 7, leaving claims 1-6 and 8 as pending in the instant application. The amendment has overcome the 35 USC 112 rejection, the claim objection of claim 3 and the drawing objection, therefore, these issues have been removed. The Applicant's response to the rejection on the merits has been carefully considered, but was not found to be persuasive, therefore the previous rejection modified as necessitated by amendment id presented below:

Examiner's Note

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Specification

A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 1-6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laverty in view of Official Notice.

In regards to claim 1, Laverty discloses a made-to-order system in an electric commerce transaction comprising:

an accepted order content confirmation means for accepting an order from a customer (FIG 3);

a design sample production means for producing design sample including image data based on data of specifications of the accepted order (col 19, lines 20-67, col 22, lines 18-27)

a design sample transmitting means for transmitting the design sample to a customer (col 21, lines); and

a confirmation means for confirming whether the order contract is accepted based on the design sample (FIG 13, item 911).

Laverty teaches an acceptance means and a fee collection means which is displayed on a customer device that can access the internet (see response to claims 1 and 2), but does not specifically mention that the customer device is a portable remote terminal, It was old and well known in the art at the time of the invention to conduct business over the internet with the use of portable devices. It would have been obvious to a person having ordinary skill in the art to include in Laverty the use of a portable remote terminal to design and approve the products for purchase in the invention, because this would permit expanded purchasing capability by users of portable devices and thus increase sales potential.

In regard to claim 2, Laverty teaches wherein said accepted order content confirmation means is capable of specifying special specifications, special design, size, color, pattern and good name on a screen of homepage;

said system further comprises database storing data of existing specifications, new special specifications and specifications of specific patterns (FIG 14 and FIG 6, item 496), and

an image synthetic processing means for overlapping a database storing specification data of existing or new special specification and specific pattern so as to search them freely (FIG 14, col 7, line 33-col 8, line 43)) and

specification data cited from the database with a half completed model image by a computer graphic (col 8, lines 29-44, system allows the incorporation of changes to existing specifications, see also FIG 6).

In regard to claim 3, Laverty teaches a manufacturing arrangement means having manufacturing instruction form in which design sample is main (FIG 4).

In regard to claims 4 -6 and 8, Laverty does not teach the specific product designs of the instant claims. However, it would have been an obvious matter of design choice to include specific product designs of the instant claims in Laverty, because the applicant has not disclosed that limiting the purchasing system of Laverty to only product items of the instant claims solves any stated problem or is for any particular purpose and it appears that the invention of Laverty would perform equally well designing and selling these items.

Response to Arguments

Applicant's arguments filed 8/16/2004 have been fully considered but they are not persuasive.

Preliminarily, applicant argues that there are significant advantages to the use of remote portable terminals, including increases in the geographic area in which customers can communicate with the system. The examiner agrees with applicant's assessment that there are significant advantages to the use of portable devices in electronic commerce, however, it is noted that the expanded geographic advantage that the applicant cites is not found in the applicant's disclosure.

In response to applicant's argument that using a portable device reduces risks associated with canceled orders, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner's stated motivation from knowledge generally available in the art, that incorporation of a portable device in Laverty "would permit expanded purchasing capability by users of

portable devices and thus increase sales" is further supported by cited reference Businesswire, which speaks to the advantages of wireless shopping and making secure purchases anywhere within the wireless coverage area, along with the importance of this sales channel.

Furthermore, applicant has failed to traverse the fact that it is old and well known to use a portable device to conduct electronic commerce; therefore, the examiner provides the following:

A "traverse" is a denial of an opposing party's allegations of fact.[1] The Examiner respectfully submits that applicants' arguments and comments *do not* appear to *traverse* what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret applicants' arguments and comments as constituting a traverse, applicants' arguments and comments *do not* appear to constitute an *adequate traversal* because applicant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a).

However, even if one were to interpret these statements to constitute a traverse, one would still be faced with the inquiry as to whether the traverse is adequate. An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is

[1] Definition of Traverse, Black's Law Dictionary, "In common law pleading, a traverse signifies a denial."

well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(703) 605-4252**. The examiner can normally be reached Monday thru Thursday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **(703) 308-1344**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist **whose telephone number is** (703) 308-1113.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7206 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

Mark Fadok

Patent Examiner